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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,948	11/24/2003	Paul R. Gagnon	03-482	5271
34704	7590	05/10/2005	EXAMINER	
BACHMAN & LAPOINTE, P.C. 900 CHAPEL STREET SUITE 1201 NEW HAVEN, CT 06510			ARYANPOUR, MITRA	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/720,948

Applicant(s)

GAGNON, PAUL R.

Examiner

Mitra Aryanpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the written indicia (as required in claim 7) and logo (as required in claim 8) must be shown or the feature(s) canceled from the claim(s).¹ No new matter should be entered. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Maged (WO 96/32979 A1).

Regarding claim 1, Maged discloses a piece of material (article 10 having two members 101 and 102) having a thickness (as best seen in figure 2b, the members have a thickness), said piece of material having an adhesive coating or layer (layer of adhesive 101b (102b)) for positioning said piece of material on a portion of an individual's face (see figure 2a). The thickness of the material is sufficient to interfere with an individual's ability to look in a specific direction at an object such as a sporting object (see page 4, lines 25-31 and page 5, lines 1-7). It should be noted that the preamble, *a sports vision training device*, does not limit the structure of the claimed device because the portion of the claim following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness. It should be noted the thickness of the piece of material inherently interferes with said individual's ability to look at any object including a sports objection.

Regarding claim 2, Maged in figure 2b shows the piece of material has a thickness, the thickness being sufficient to direct the individual's vision up and toward the field of play and players on said field of play (page 5, lines 1-7).

Alternatively:

4. Claims 1-4, 6, 9-12, 14-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Micchia et al (4,719,909).

Regarding claim 1, Micchia et al discloses a piece of material (patch 7) having a thickness (as best seen in figure 2, the patch has a thickness), said piece of material having an

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adhesive coating or layer (adhesive layer 13) for positioning said piece of material on a portion of an individual's face (see figure 1); the thickness of the material is sufficient to interfere with an individual's ability to look in a specific direction at a sporting object (column 2, lines 14-45). It should be noted the thickness of the piece of material inherently interferes with said individual's ability to look at any object including a sports objection.

Regarding claim 2, Micchia et al shows in figure 2, the piece of material has a thickness, the thickness being sufficient to inherently direct the individual's vision up and toward the field of play and players on said field of play.

Regarding claim 3, Micchia et al shows said piece of material (patch 7) is formed from a porous material (see column 2, lines 22-27) on one side and a pliable sheet material such as medical adhesive bandages on the opposite side (see column 2, lines 28-36). It should be noted that the common and well-known medical adhesive bandages are formed from open-cell foam material.

Regarding claim 4, Micchia et al shows said adhesive coating or layer includes means for absorbing moisture and for transferring said moisture from a surface of an individual's skin to the piece of material to allow the moisture to evaporate (see column 3, lines 38-42).

Regarding claim 6, Micchia et al shows said piece of material (patch 7) has an upper surface (light absorbing surface 12) and said upper surface is intermittently grooved (see figure 2; also see column 2, lines 46-55), to permit momentary glances at said sports object.

Regarding claim 9, Micchia et al shows said device is disposable (see column 3, lines 35-37).

Regarding claim 10, note the rejection of claims 1, 2 and 9.

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Regarding claim 11, note the rejection of claim 3.

Regarding claim 12, note the rejection of claim 4.

Regarding claim 14, note the rejection of claim 6.

Regarding claim 15, Micchia et al shows said vision restriction devices are attached to an individual's face along side each eye to inherently restrict the individual's peripheral vision (see figure 1).

Regarding claim 16, note the rejection of claim 3.

Regarding claim 18, during normal use and operation of the Micchia et al device, the method step set forth by applicant in the claim is inherently provided.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Micchia et al (4,719,909).

Regarding claims 7 and 8, Micchia et al does not disclose expressly the addition of indicia or logo on the upper surface of the piece of material. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to include indicia or logo on the upper surface of the piece of material, because Applicant has not disclosed that the inclusion of indicia or logo, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have

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expected Applicant's invention to perform equally well with either the piece of material taught by Micchia et al or the claimed piece of material because both material perform the same function of improving under-eye light absorbing device which can be easily applied and easily stripped in one piece as desired. Therefore, it would have been an obvious matter of design choice to modify Micchia et al to obtain the invention as specified in claims 7 and 8.

7. Claims 5, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Micchia et al (4,719,909) in view of Morgan et al (4,951,658).

Regarding claim 5, Micchia et al does not disclose expressly that the moisture absorbing and transferring means comprises a hydrocolloidal material incorporated into the adhesive layer. Morgan et al shows the use of hydrocolloidal material incorporated into the adhesive layer. Morgan et al teaches that hydrocolloidal materials have indeed been used successfully for many years by general surgeons and internists to cover burns, pressure sores and wounds. Morgan et al further teaches that the presence of the hydrocolloidal material with the pressure sensitive adhesive assures that the patch can remain in place for an extended period, without the adhesive bond being so weakened by sweat or other moisture that it could only hold the patch in place for the short period of time in which the adhesive of known patches are effective. Furthermore, the hydrocolloidal material draws moisture away from the interface between the adhesive and the skin, avoiding the problems of skin rashes and trauma to the skin upon removal of the patch. In view of the teachings of Morgan et al it would have been obvious to incorporate hydrocolloidal material in the adhesive layer of Micchia et al, the motivation being to strengthen the adhesive bond and to draw moisture away from the interface between the adhesive and the skin, avoiding the problems of skin rashes and trauma to the skin upon removal of the patch.

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Regarding claim 13, note the rejection of claims 4 and 5.

Regarding claim 17, note the rejection of claim 5.

Response to Arguments

8. Applicant's arguments filed 07 March 2005 have been fully considered but they are not persuasive. With regards to applicant's assertion that neither Maged nor Micchia et al show the piece of material having a thickness sufficient to interfere with an individual's ability to look in a specific direction at a sporting objects being controlled by the individual. The claims as presented do not require the material to have a specific thickness. The claims merely require the material have a thickness sufficient to interfere with... Again the claim does not require the thickness to be in a specific range. Both references show the material to have sufficient thickness that could interfere with the user's ability to look in a specific direction. Applicant is merely suggesting that the thickness of the material will cause interference. Any material positioned under the eyes will cause some degree of interference with the field of vision, whether it is in a sporting environment or any other environment.

Regarding applicant's assertion that it is not true that the material of Micchia et al would perform equally well with indicia or logo. It is unclear how applicant has reached such a conclusion, since the use of indicia or logo is not uncommon in a sporting environment. Comiskey et al clearly teaches the use of indicia. Cosmiskey et al shows the indicia can be color, letters or figures. Applicant has not disclosed that providing indicia on the material yields to unexpected results.

The use of hydrocolloidal materials is commonly known. However, since applicant has requested the examiner to supply a reference which shows the use of a hydrocolloidal material

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incorporated into an adhesive layer, the Morgan reference has been introduced. Morgan et al teaches that hydrocolloidal materials have indeed been used successfully for many years by general surgeons and internists to cover burns, pressure sores and wounds.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

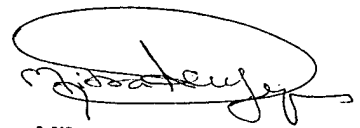
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 571-272-4405. The examiner can normally be reached on Monday - Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA
02 May 2005



MITRA ARYANPOUR
PRIMARY EXAMINER